

REMARKS

Status of the Application

Claims 1-9 and 11-31 are the claims that have been examined in the instant application. Claims 1-9 and 11-29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10-23 of co-pending Application No. 10/391,597. Claims 1-2, 6-7, 12-16, 20-21 and 25-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,943,909 to Goldstein et al. in view of U.S. Patent No. 5,722,076 to Sakabe. Claims 3, 5, 8, 11, 17, 19, 22 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Goldstein et al. in view of to Sakabe further in view of the Official Notice. Claims 4, 9, 18 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,943,909 to Goldstein et al. in view of U.S. Patent No. 5,722,076 to Sakabe further in view of the admitted prior art.

By this Amendment, Applicants are amending claims 1, 7, 15, 21 and 28, and are canceling claims 2 and 16.

Double Patenting

Claims 1-9 and 11-29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10-23 of co-pending Application No. 10/391,597.

The double patenting rejection must necessarily be provisional double patenting since they are based on pending applications rather than issued patents. Thus, at the present time,

Applicants hereby request that the Examiner hold the filing of any terminal disclaimers in abeyance until the claims are in condition for allowance.

Claim Rejections - 35 U.S.C. § 103

A. *Claims 1-2, 6-7, 12-16, 20-21 and 25-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,943,909 to Goldstein et al. in view of U.S. Patent No. 5,722,076 to Sakabe.*

Claim 1 is hereby amended to incorporate the subject matter of claim 2 and claim 15 may be amended to incorporate the subject matter of claim 16, with claims 7, 21 and 28 being rewritten in independent form. With respect to the subject matter of claims 2, 7 and 28, Applicants would maintain that these claims are still patentable for the reasons set forth in the Amendment filed February 14, 2007. The Examiner has maintained the same argument with regard to claims 2, 7 and 28 as was presented in the Non-Final Office Action dated November 15, 2006. However, the Examiner does not respond to the substance of Applicant's argument regardint lack of inherent disclosure of the image server. MPEP §707.07(f) requires that “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the Applicant's argument and answer the substance of it. Because the Examiner has repeated the rejection, however, the Examiner has not properly responded to the argument, and, because the argument remains unrebutted, the subject matter of claims 2, 7 and 28 should be patentable at least for the reasons outlined in the Amendment of February 14, 2007.

Specifically, amended claims 1 recites “an image server connected to the wireless communication apparatus via the wired communication line, for storing said image data sent

from the wireless communication apparatus.” Claims 7, 15, 21 and 28 recite similar limitations. The Examiner cites to col. 7, lines 45-53 of Goldstein as teaching this aspect of the claimed invention, stating that an image server is inherent based on the disclosure. However, the cited passage of Goldstein simply indicates that the service provider provides the requested services. There is no indication that the service provider inherently includes an image server as recited in amended claim 1. Specifically, col. 7, lines 45-53 simply states that if image data is acceptable to be processed, then the service provider provides the requested services; no mention is made that the image data sent from the wireless communication apparatus is stored in any manner, as would be necessary to argue the inherency of an image server. Therefore, claims 1, 7, 15, 21 and 28 are patentable over the applied art.

B. Claims 3, 5, 8, 11, 17, 19, 22 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,943,909 to Goldstein et al. in view of U.S. Patent No. 5,722,076 to Sakabe further in view of the Official Notice.

Claims 3, 5, 8, 11, 17, 19, 22 and 24 are dependent from amended claims 1, 7, 15, and 21. Thus, because the proposed combination of Goldstein and Sakabe fail to disclose all of the elements of amended claims 1, 7, 15, and 21, and because the Examiner’s Official Notice fails to cure the deficient disclosure of the proposed combination of Goldstein and Sakabe, claims 3, 5, 8, 11, 17, 19, 22 and 24 are patentable at least by virtue of their respective dependencies.

C. Claims 4, 9, 18 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,943,909 to Goldstein et al. in view of U.S. Patent No. 5,722,076 to Sakabe further in view of the admitted prior art.

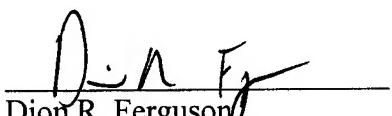
Claims 4, 9, 18 and 23 are dependent from amended claims 1, 7, 15, and 21. Thus, because the proposed combination of Goldstein and Sakabe fail to disclose all of the elements of amended claims 1, 7, 15, and 21, and because the Admitted Prior Art fails to cure the deficient disclosure of the proposed combination of Goldstein and Sakabe, claims 4, 9, 18 and 23 are patentable at least by virtue of their respective dependencies.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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23373
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Date: July 23, 2007